REMARKS

Claims 1-19 are pending in the application. Whereas the Examiner has withdrawn the previous rejection of the claims under 35 U.S.C. §102(b), all claims have now been rejected under 35 U.S.C. §103(a) as being an obvious variation on the May reference in view of Li, et al. (U.S. Patent No. 5,608,899). Claim 4 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over May, et al, in view of Li, et al., and further in view of Swix, et al. (U.S. Patent No. 6,718,551).

Reconsideration and allowance in view of the following remarks is respectfully requested.

The combination of the May and Li references fail on two grounds: (1) there is no suggestion in the art that May and Li could or should be combined, and (2) even if combinable, the references together do not teach all elements of the claimed invention.

I. There is No Suggestion to Combine Features of the May and Li References

The Federal Circuit has been consistent in reversing the PTO when a rejection is made on the basis of hindsight, that is when an Examiner rejects the application under 35 U.S.C. §103(a) grounds as obvious under a combination of two or more patents without any specific suggestion within the patents to combine the features. In re Rouffett, 47 USPQ2d 1453 (Fed. Cir. 1998), the Federal Circuit refused to uphold an obviousness rejection, even where skill in the art is high, absent the specific identification of principal, known to one of ordinary skill in the art that suggests the claimed combination.

The Federal Circuit reemphasized the care to be taken when combining prior art references in obviousness findings in Ecolochem v. Southern Cal. Edison, 56 USPQ2d 1065 (Fed. Cir. 2000), stating that such absence of evidence to combine prior art references "is defective as hindsight analysis." The Federal Circuit held similarly in In re Kotzab, 55 USPQ2d 1313 (Fed. Cir. 2000), reversing the PTO and stating that, "[i]dentification of prior art statements that, in abstract, appear to suggest claimed limitation does not establish prima facie case of obviousness without finding as to specific understanding or principal within knowledge of skilled artisan that would have motivated one with no knowledge of the invention to make the combination in the manner claimed."

Finally, the Federal Circuit has reaffirmed their view that the PTO used improper hindsight analysis to reject patent claims under §103(a) in the recent case of In re Lee, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002), stating that a specific suggestion in the prior

art cited is required and not a simple citation to "common knowledge and common sense." Lee includes a tour-de-force of case law directed to the issue of combining references including those as follows:

- "The factual inquiry whether to combine references must be thorough and searching. . . . It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with." (Lee, 277 F.3d at 1343)
- "A showing of a suggestion, teaching, or motivation to combine the prior art references is an essential component of an obviousness holding." (*quoting* Brown & Williamson Tobacco Corp. v. Philip Morris, Inc., 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000)
- "Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis if rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." (*quoting* C.R. Bard, Inc. v. M3 Systems, Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998)
- "There must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant." (*quoting* In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998)
- "Teachings of references can be combined *only* if there is some suggestion or incentive to do so." (*quoting* In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) (emphasis in original)

The Patent Office has failed to display the rigor required by the Federal Circuit holdings in demonstrating a suggestion within the art that the cited prior art references should be combined.

II. Not All Elements of the Claims Are Taught by the Combination of May and Li

It is quite clear that May fails to teach the selection of two or more top level categories from a list of such categories and then presenting a sub-list resulting in a compile of the category selections. Column 5, lines 33-37, disclose that the user selects a (single) focused cell resulting in a new matrix being displayed associated with the focused cell. Claims 40 and 41 of the May reference (Col. 32, lines 35-65) specify quite clearly that a first selection of a parser cell within a matrix results shows a second matrix "subordinate to the

focused parser cell" and that a second user input to select the focused parser cell displays a "subordinate matrix." It is clear, then, that only one focused cell can be selected at any one time within a particular matrix.

The Examiner notes on page 6 of the Office Action that the step of "selecting at least two of the top-level categories from the list" is accomplished by vague language within May that "filters the title of the cells that are available at...." (Col. 5, lines 45-47). One knowledgeable in the art would not equate the two features since May is incapable, for reasons explored in detail in applicants' previous responses, of handling selection of two or more top-level categories. That is, search cells invoking this filter are not disclosed anywhere within May as allowing a filter to take place among two or more simultaneously selected top level categories. Instead, the patent refers to results from a search to be in the form of a "linearized subtree" (see, *e.g.*, Col. 17, line 66) where only one selection within a displayed search matrix (read "concatenated" at Col. 18, line 55) can be displayed at one time. There is no reference within May that suggests that two top-level categories can be selected from within a list at any one time. That is, the present Office Action (p. 3) states:

> May et al. does not teach selecting for presentation to the user under control of the processor in a single compile a sub-list of only those media content items associated with all of the two or more top-level categories selected by the user.

However,

> Li et al. teaches selecting for presentation to the user under control of the processor in a single compile a sub-list of only those media content items associated with all of the two or more top-level categories selected by the user. (See Li et al. column 3, lines 26, 57)

Applicants disagree with the above statement on the grounds that Li compiles a search using logic OR rather than logic AND as in the present invention. That is, rather than teach a selection process using a logic AND statement (as required by the limitation "all of the two or more" in the claims), Li teaches the direct opposite:

> As shown in FIG. 2B, when a check box for a category such as "SONY" is checked, the query statement used to generate the original chart is modified to reflect the selection. In addition, the user may select multiple categories by selecting multiple check boxes. When multiple boxes are checked, these conditions are preferably in logical OR relationship with each other. (Li et al., Col. 3, lines 28-34)

Li, therefore, composes the query to display a list of those items in which any one of the selected elements is present. The result from such a query yield very different results than the present invention. In fact, it is not clear that Li could even be modified to present intersection results since the data presented as examples in the drawings (see, e.g., FIG. 2B showing market share from Sony, Panasonic, Aiwa, Sanyo, and Other) are mutually exclusive and would not benefit from an AND analysis. Accordingly, one cannot infer such a compile from the Li reference and Li cannot therefore be properly combined with the May reference to teach each and every feature of the claims.

That is, Li cannot perform the step of, "selecting for presentation to the user under control of the processor in a single compile a sub-list of only those media content items associated with all of the two or more top-level categories selected by the user." Accordingly, reconsideration and allowance of the claims is respectfully requested.

For the foregoing reasons, allowance of claims 1-19 of the application amended is solicited. The Examiner is encouraged to telephone the undersigned at (503) 222-3613 if it appears that an interview would be helpful in advancing the case.

Respectfully submitted,

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